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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,688	03/22/2002	Klaus Fischer	F-7028	3254

7590 02/26/2003

Jordan and Hamburg  
122 East 42nd Street  
New York, NY 10168

EXAMINER
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SAYALA, CHHAYA D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 02/26/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/868,688

Applicant(s)

FISCHER ET AL.

Examiner

C. SAYALA

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11 and 19, line 1, "humic-like" is indefinite and of indeterminate scope.

In claim 12, line 3, "is activated alkaline" should be corrected to remove the typographical error.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Van der Wenter et al. (US Patent 5302524).

Van der Wenter et al teaches a process for producing a coal derived oxidation product that contains humic acids comprising adding ammonium hydroxide to raise the pH to 4 to 9. The second step reacts this with oxygen or air in a mixture under suitable temperature and pressure to produce the oxidized product. The oxidation step occurs at a temperature 100<sup>0</sup>C-300<sup>0</sup>C. Suitable pressures are given at lines 60-65 at col. 3.

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See col. 3, lines 8-18, 40-45, 50-53, 60-65. The coal is particulate (col. 3, lines 35-40). The oxidation is carried out in a period of time shown at col. 4, lines 1-3. The patent does not teach the art of ammonia solution added but since the intent is the same i.e. to raise the pH, this must be inherent. At lines 1-5, col. 8, the patent reports that the addition of nutrients to the oxihumate/oxicoal produced better results. See expts 1 and 2, which shows phosphorus also. Fig. 1 anticipates claim 21. The C/N ratio is shown by the analyses tables, given as individual amounts of C and N. Claims 19 and 20 are written in a product-by-process format and therefore it is the novelty of the instantly claimed product that need be established and not that of the recited process steps. In *re Brown*, 173 USPQ 685 (CCPA 1972); In *re Wertheim*, 191 USPQ (CCPA 1976). Furthermore, with regard to the characteristics recited therein relating to various percentages, when an examiner obtains a product which reasonably appears to fall within the scope of that which is claimed by a patent applicant, it is reasonable to shift the burden to the applicant to provide evidence showing that the product of the prior art does not fall within the scope of applicants' claims because of the PTO's inability to manufacture products and obtain and compare prior art products. See *In re Swinehart*, 439 F.2d 210, 169 USPQ 226, (CCPA 1971); *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

5. Claims 11-16, 19-21 rejected under 35 U.S.C. 102(b) as being anticipated by Fischer et al. (US Patent 5720792).

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Fischer et al. teach the oxidative ammonolysis of lignin. The patent teaches that lignite sludges, pulverized brown coal, waste liquors from pulp processes (col. 1, lines 60+, col. 2, lines 1-20) may be used for their process. The lignin is dissolved in ammonia to obtain a pH of 9 (col. 2, lines 45+) and is heated. The reactor is heated at below 100°C and then air/oxygen is introduced. Reaction time is about 5 hours. The amounts of C, N, etc. are similar, see col. 3, lines 1-15 as are other percentages claimed herein which fall within the reference ranges.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van de Wenter et al. (US Patent 5342524) in view of EP 282250.

The patent '524 teaches all the limitations of claims 1-15, 17-21. It does not teach adding other lignitic materials. However, the EP patent, also drawn to the same inventive endeavor, teaches that the other lignitic materials claimed herein in instant claim 16, also contain humic acid and are equivalent to brown coal. (See page 2, lines 23-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use such materials instead of or in addition to lignins of Van de Wenter, with the reasonable expectation that a similar product would be formed.

***Claim Rejections - 35 USC § 102/ 103***

8. Claims 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SU 333156.

The process is the same or similar. The rejection is being made under both statutes because claims 19 and 20 are written in a product-by-process format and therefore it is the novelty of the instantly claimed product that need be established and not that of the recited process steps. *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 191 USPQ (CCPA 1976). Furthermore, with regard to the characteristics recited therein relating to various percentages, when an examiner obtains a product which reasonably appears to fall within the scope of that which is claimed by a patent applicant, it is reasonable to shift the burden to the applicant to provide evidence showing that the product of the prior art does not fall within the scope of applicants' claims because of the PTO's inability to manufacture products and obtain and compare prior art products. See *In re Swinehart*, 439 F.2d 210, 169 USPQ 226, (CCPA 1971); *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

9. Claims 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SU 1763437 or Davis et al. (US Patent 2027766) or Karcher et al. (US Patent 3111404).

SU '437 teaches a process for fertilizer production which is similar. Davis et al. Teach a process for making a fertilizer which uses oxidative ammonolysis (see col. 1 at page 2). Karcher et al. Teaches a similar oxidative ammonolysis process for leonardite. See claim 1 and col. 3. The rejections of each of these references are being made under both statutes because claims 19 and 20 are written in a product-by-process format and therefore it is the novelty of the instantly claimed product that need be established and not that of the recited process steps. In re Brown, 173 USPQ 685 (CCPA 1972); In re Wertheim, 191 USPQ (CCPA 1976). Furthermore, with regard to the characteristics recited therein relating to various percentages, when an examiner obtains a product which reasonably appears to fall within the scope of that which is claimed by a patent applicant, it is reasonable to shift the burden to the applicant to provide evidence showing that the product of the prior art does not fall within the scope of applicants' claims because of the PTO's inability to manufacture products and obtain and compare prior art products. See *In re Swinehart*, 439 F.2d 210, 169 USPQ 226, (CCPA 1971); *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

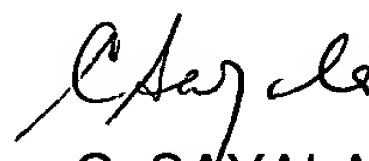
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA at Group 1761, telephone number (703) 308-3035.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0661.

  
C. SAYALA  
Primary Examiner  
Group 1700.